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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,062	03/30/2006	Samuel J. Maggio	ICM001CP	9779
51414 7590 10/27/2009				
GOODWIN PROCTER LLP				
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EXCHANGE PLACE				
BOSTON, MA 02109-2881				
EXAMINER				
HURLEY, KEVIN				
ART UNIT		PAPER NUMBER		
3611				
NOTIFICATION DATE		DELIVERY MODE		
10/27/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/574,062

Applicant(s)

MAGGIO, SAMUEL J.

Examiner

KEVIN HURLEY

Art Unit

3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 11-14 and 18-24 is/are pending in the application.
4a) Of the above claim(s) 8-10 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-14 and 18-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14, 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 6, 12, 18, 21, 23 contain the terms “substantially closed perimeter”, “adapted substantially for rolling”, “substantially parallel”, “substantially closed perimeter”, or “substantially closed polygon” which lacks a clear and precise definition and whose meaning is completely dependent on a person’s subjective opinion. As such, one of ordinary skill in the art could not determine the metes and bounds of the claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The use of the phrase “adapted” has been noted in the claims. It has been held that the recitation that an element is “adapted” is not a positive limitation but only requires the ability to perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ

138 (CCPA 1946).

5. Claims 1-7, 11-14, and 18-24 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Hopkins 4,765,773.

Hopkins discloses a surface traversing apparatus adapted to be adhered to a surface by a partial vacuum, the apparatus comprising:

a frame 27 forming a chamber;

a seal having a closed seal perimeter defining an opening of the chamber, the seal perimeter having a plurality of rollers 23-26 mounted in parallel on opposite sides of the frame and rolling relative to the chamber; and

a drive 10 configured to move the apparatus relative to the surface;

the rollers comprising a compressible outer surface;

wherein a portion of the seal perimeter comprises two tracks 29 mounted in parallel on opposite sides of the frame;

a means 86 for maintaining the apparatus in contact with the surface;

the seal perimeter comprising a quadrilateral;

a processor 16 for controlling the apparatus.

Response to Arguments

6. Applicant's arguments filed 14 July 2009 have been fully considered but they are not persuasive.

Applicant has submitted that the terms "substantially closed perimeter", "adapted

substantially for rolling”, “substantially parallel”, and “substantially closed polygon” as recited in claim 1, 6, 12, 18, 21, 23 are definite because one of ordinary skill in the art would know what was meant by the above identified terms. However, applicant has offered no evidence why this is so. Applicant has presented some definitions for the above but can show no evidence in the specification or elsewhere why one of ordinary skill in the art would recognize such definitions.

Regarding the rejection of the claims under 35 U.S.C. § 102(b) as being anticipated by Hopkins, applicant has argued that Hopkins fails to disclose a seal which is adapted to maintain a vacuum seal with the surface sufficient to adhere the apparatus to the surface. As noted previously, the term "adapted" only indicates intended use. The claim fails to recite any actual structure which is not disclosed by Hopkins.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN HURLEY whose telephone number is (571)272-6646. The examiner can normally be reached on Monday-Friday 9:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin Hurley/
Primary Examiner, Art Unit 3611

October 22, 2009